

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD F. BREZIC

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Appeal No. 2003-1695  
Application No. 09/771,072

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ON BRIEF

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Before OWENS, WALTZ, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 68 through 79, 104 through 109, 112 and 113 which are all the claims pending in this application other than claims 80 through 103, 110 and 111 which stand withdrawn from consideration pursuant to a requirement for restriction or election.

### THE INVENTION

The invention is directed to a golf hole insert having a cover and a cover mount. The cover is of a size sufficient to reduce the area of the top opening of a golf hole to prevent a golf ball from passing through the opening. Additional limitations are described in the following illustrative claim.

### THE CLAIM

Claim 68 is illustrative of appellant's invention and is reproduced below:

68. A golf hole insert to be inserted in a golf hole and to prevent a golf ball from fully dropping into a golf hole having a peripheral wall, a bottom wall contiguous with the peripheral wall and a top opening opposite the bottom wall, said golf hole insert comprising a cover and a cover mount, said cover reducing the area of the top opening of said golf hole to prevent said golf ball from fully passing through the top opening of said golf hole when said cover is at least partially inserted in said golf hole, said cover mount at least partially engaging said peripheral wall to releasably secure said cover and cover mount in said golf hole and suspending said cover and cover mount above said bottom wall of said golf hole.

### THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references:

Scanlan	1,882,963	Oct. 18, 1932
Van Holt, Jr. (Van Holt)	5,415,397	May 16, 1995
Owen, Jr. et al. (Owen)	5,524,891	Jun. 11, 1996

### THE REJECTIONS

Claims 68 through 79, 104 through 109, 112 and 113 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scanlan in view of Van Holt.

Claims 68 through 79, 104 through 109, 112 and 113 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Holt, in view of Owen.

### OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner and agree with the appellant that the rejections of the claims under 35 U.S.C. § 103(a) are not well founded. Accordingly, we reverse both rejections.

#### The Rejection under Section 103(a) over Scanlan and Van Holt, Jr.

It is the examiner's position that, "[i]t would have been obvious to one of ordinary skill in the art to have used a cover mount such as Van Holt's with Scanlan's device if it was desired to support the device by the sides of the hole and reduce the amount of material necessary to construct the device." See Office action dated December 03, 2001, paper no. 7, page 2. Similarly, the examiner has stated that, "knowledge generally available to one of ordinary skill in the art was that golf hole plugs may be mounted in the hole in various ways. One wishing to improve on one such device would obviously have considered the merits of the other." See Answer, page 4. We fail to find the requisite

motivation to combine the references in either of the above statements and accordingly, we decline to sustain the examiner's position on the record before us.

Scanlan is directed to a filler cover for golf holes. See column 1, lines 1-2. The golf hole fillers may be in the form of a cylindrical metallic body as illustrated in Figure 1, column 2, lines 51-58. We find that the cups are closed by the filler covers. See column 2, lines 96-97. In a second embodiment, a cylindrical block of wood having an outer diameter substantially equal to that of the opening in the golf hole completely fills the hole. See Figures 5 and 6, page 1, column 1, lines 24-36. The structures of Scanlan's filler covers are complete in and of themselves. They completely fill a golf hole and cover it. There is no need to modify the structure of Scanlan by providing a cover to a structure that already completely fills a golf hole and functions as a cover for the golf hole. Accordingly, there is no reason or motivation to combine Scanlan with Van Holt.

As for considering the merits of the "other" as proposed by the examiner, in our view the combination of an insert and a cover mount as suggested by the examiner is found only in the specification before us. Based upon the above finding and analysis, we conclude that the examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references").

The Rejection under Section 103(a) over Van Holt Jr. and Owen

There is no dispute that Van Holt discloses a structure within the scope of the claimed subject matter other than the size of the diameter of the hole. In this respect Van Holt is directed to a device when placed within a golf hole decreases its target diameter. See column 1, lines 22-26. As Van Holt states, "[t]he central aperture or opening measures two and one half inches across, thus being of sufficient size to allow a golf ball to pass therethrough." See column 3, lines 50-52. See also the Abstract. We note that Van Holt further discloses that when a device 10 is in place, "the diameter of the hole is reduced from the regulation  $4\frac{1}{4}$  inches to  $2\frac{1}{2}$  inches. It should be noted that the amount that the diameter is reduced, is not limited to this amount but could be less or more as desired." See column 4, line 65 to column 5, line 1. With respect to the size of a golf ball, the appellant has stated, that, "[a] standard golf ball has a diameter that is less than two inches," Brief, page 20, which statement has been concurred with, in the Answer, page 6. Having determined the size of a golf ball, it is clear that there is no suggestion in Van Holt, that the golf hole is reduced to a size sufficient that the golf ball is prevented from passing through the golf hole. Stated otherwise there is no suggestion that the training device disclosed by Van Holt is reduced to such an extent that the golf ball does not pass through the reduced diameter golf hole.

In this context, Owen is relied upon by the examiner for teaching that a practice

hole may be made as large or as small as desired. See Office action dated December 03, 2001, page 3. Owen however, is directed to a golf training device. See column 1, lines 6-10. Owen states that an object of the invention is to define a golf hole, "having a rim that is variable in diameter." See column 2, lines 1-7. The variable diameter practice golf hole of Owen has a support mechanism that is movable between a minimum and a maximum diameter. See column 2, lines 20-28. Owen states that, "the actual minimum diameter of hole 42 is approximately 2 inches. Likewise, the actual maximum diameter is approximately 4½ inches. The minimum and maximum hole diameters can, of course, be larger or smaller than the above-described values depending upon the application of the training device." See column 6, lines 38-47. Accordingly, the teaching of Owen is likewise directed to a practice golf hole wherein the golf ball can pass through the golf hole. There is in Owen no teaching or suggestion for reducing the size of the hole so as to prevent the golf ball from passing through the golf hole. That conclusion is read into the teachings of the reference by the examiner. When the examiner's conclusion is considered in light of the totality of the record before us, it constitutes a hindsight conclusion. Accordingly, the rejection of the examiner is not sustainable.

### DECISION

The rejection of claims 68 through 79, 104 through 109, 112 and 113 under 35 U.S.C. §103(a) as being unpatentable over Scanlan in view of Van Holt is reversed.

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The rejection of claims 68 through 79, 104 through 109, 112 and 113 under  
35 U.S.C. §103(a) as being unpatentable over Van Holt, Jr. in view of Owen is reversed.

The decision of the examiner is reversed.

REVERSED

TERRY J. OWENS  
Administrative Patent Judge

THOMAS, A. WALTZ  
Administrative Patent Judge

PAUL LIEBERMAN  
Administrative Patent Judge

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